

REMARKS

Claims 53-67 are pending in the present application. Claims 43-52 have been canceled without prejudice or disclaimer of the subject matter described to clarify issues for appeal while reserving the right to pursue this subject matter. Claim 59 has been amended. No new matter has been added. Consideration of the pending Claims is respectfully requested in view of the following remarks.

Drawings

The drawings were objected to under 37 CFR§1.83(a) for not showing every feature of the invention specified in the claims. Specifically, the limitations of Claim 42 of:

determining whether said email message is a first type of email message or a second type of email message;

executing a first application operable on said communication terminal to read only said first type of email message; and

executing a second application operable on said communication terminal to read at least said second type of email message,
were indicated as not present in the drawings.

Although Claim 42 has been canceled, Applicant respectfully traverses these assertions since the cited portions of Claim 42 are fully supported in the drawings. For example, step SA6 in Fig. 10 illustrates determining whether an email message is first type of email message (native mailer) or a second type of email message by determination of whether "a mailer identifier = a native mailer?". (see also

paragraphs [0056]-[0059]) In addition, executing first and second applications to read respective first and second types of email messages is illustrated by Fig. 4 in which an e-mail application and a Java Application (application mailer) are illustrated, and by Figs. 5-12 in which operation of the application mailer is illustrated. A full description of the first and second types of email messages is also included in at least paragraphs [0039] – [0078]. For at least these reasons, Applicant respectfully requests withdrawal of the objections to the drawings since pursuant to 37CFR§1.83(a), all the features of the invention specified in the claims is shown in the drawings.

The 35 USC §112 second paragraph rejection

Claim 59 was rejected pursuant to 35 U.S.C. §112 second paragraph for reciting the limitation "said processor." Applicant has amended Claim 59 to correct this scrivener's error by replacing the terms "said processor" with the terms "said control unit," which is described in Claim 53. Entry of this non-narrowing amendment is respectfully requested since the amendment is to correct a scrivener's error, presents the claim in better form for condition on appeal, and because pursuant to 37 CFR §1.116(b)(1), the amendment was made to comply with a requirement of form expressly set forth in the office action mailed April 7, 2008. Thus, Applicant respectfully requests withdrawal of the 35 U.S.C. §112 second paragraph rejection of Claim 59.

The 35 U.S.C. §103(a) Claim Rejections

Claims 43-50, 52-63, and 66-67 were rejected pursuant to 35 U.S.C. §103(a) as being obvious in view of U.S. Patent Publication No. 2002/0046249 A1 to Shiigi (hereinafter "Shiigi") in combination with US Patent No. 7,328,244 to Kelley (hereinafter referred to as "Kelley"). In addition, Claim 51 was rejected pursuant to 35 U.S.C. §103(a) as being unpatentable over Shiigi as modified by Kelley and US Patent No. 6,809,724 to Shiraishi (hereinafter referred to as "Shiraishi"). Also, Claims 64 and 65 were rejected pursuant to 35 U.S.C. §103(a) as being unpatentable over Shiigi as modified by Kelley and U.S. Patent Publication No. 2002/0016823 A1 to Ueno et al. (hereinafter "Ueno"). Claims 43-52 were canceled rendering these rejections moot. Applicant respectfully traverses the rejections of Claims 53-67 because none of cited references, either alone or in combination, teach or suggest each and every limitation of Claims 53-67, and a *prima facie* case of obviousness is unsupported.

For example, Claim 53 describes a communication terminal comprising a control unit configured to determine whether said email message is a first type of email message or a second type of email message that is different from said first type of email message. As correctly indicated on page 9 of the office action mailed April 7, 2008, Shiigi fails to teach or suggest such a determination. However, on page 8 of the office action, it is asserted that Shiigi's client computer 210 included a control unit further configured to execute a first application operable on said communication

terminal to read only said first type of email message, and said control unit further configured to execute a second application operable on said communication terminal to read at least said second type of email message.

In fact, Shiigi describes a standard email client (260), and a client computer (230) having a web browser with a handwriting Java client (210a) (paragraph 32 and Fig. 2B), however, Shiigi does not describe the standard email client (260) and the handwriting client (210a) as residing on a single device. Instead, as clearly illustrated in Figure 2B, each of Shiigi's client computers includes **either** a handwriting Java client 210a **or** an Internet email client. Shiigi further describes an IMAP server that sends an email with a GIF file attachment to those client computers operating an Internet email client (paragraphs [0043]-[0044]), **or** sending the email with the GIF file attachment to a server computer 220 for conversion of the GIF file into pixel data prior to sending to a handwriting client. (paragraphs [0045]-[0046]).

Thus, not only do Shiigi's client computer's have no need for a determination of whether an email message is a first type of email message or a second type of email message, but also Shiigi's client computers do not execute a first application operable on a communication terminal to read a first type of email message and a second application operable on said communication terminal to read a second type of email message. MPEP §2141 provides that to establish a prima facie case of obviousness under 35 U.S.C 103(a) an examiner is required to resolve factual inquiries according to *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). The requirement of resolving

these factual inquiries was recently reiterated by the Supreme Court in *KSR Int'l Co. v. Teleflex, Inc.*, 82 USPQ2d 1385 (2007). Among these factual inquiries, an Examiner must accurately determine the scope and content of the prior art. See MPEP §2141(II.A.). In the present application, the scope and content of cited prior art has not been accurately determined because Shiigi does not teach or suggest both a first application and a second application operable on the same client computer.

Moreover, it was acknowledged that Shiigi does not describe a control unit configured to determine whether said email message is a first type of email message or a second type of email message. (see page 9 of the office action) Thus, Shiigi's client computers do not have the capability to figure out whether to execute a first application or a second application as claimed. To bridge this gap, it has been asserted that Kelley describes a control unit configured to determine whether said email message is a first type of email message or a second type of email message. In fact, Kelley describes a system for categorizing emails into email folders based on a category identifier included in a header of each email prior to each email being sent. (Col. 5 lines 39-48, and Col. 6 lines 13-22)

Thus, the asserted combination of Shiigi and Kelley do not meet the limitations of, and/or teach away from the limitations of Claim 53 since combining Shiigi with Kelley simply provides the system of Shiigi with the capability to store email messages in folders based on header identifiers as described by Kelley. Applicant respectfully asserts that imparting any additional functionality into the combination of Shiigi and Kelley constitutes an inaccurate determination of the scope

and content of the prior art (See MPEP §2141(II.A.)), since Kelley clearly teaches a system directed to simply categorizing emails messages in headers to make it friendly and efficient for a user to find such categorized emails, and Shiigi does not teach or suggest first and second applications, as previously discussed.

Moreover, the fact that the combination of Kelley with Shiigi simply provides Shiigi with email categorization was apparently acknowledged on page 9 of the office action mailed April 7, 2008. Thus, Applicant respectfully asserts that the recited portions of Shiigi and Kelley, when combined do not result in the limitations described in Claim 53 and no reasoning for arriving at the claimed invention has been explicitly articulated in the office action mailed April 7, 2008. As made clear in *KSR Int'l Co. v. Teleflex, Inc.*, 82 USPQ2d 1385 (2007) rejections on obviousness grounds cannot be sustained by mere conclusory statements, but must instead be based on clearly articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.

Claim 56 describes that only said first application is executable to communicate with said email server to transmit and receive email messages. On page 10 of the office action mailed April 7, 2008, it was asserted that Shiigi described such limitations. Applicant respectfully traverses these limitations since even Shiigi very clearly describes that client computers having a handwriting Java client, and client computers having an Internet email client are both capable of communication with an email server to transmit and receive email messages since each of these clients is operated by itself on one of Shiigi's client computers.

Claim 57 describes that the second application is executable to enable said first application to transmit a second email message, to a designated recipient, that is generated for transmission with only said second application, to include a header and an email address of a designated recipient of said second email message. Neither Shiigi nor Kelley teach or suggest a second application executable to enable a first application to transmit an email message as described in Claim 57. To the contrary, Shiigi describes two separate and wholly independent applications, namely, handwriting messaging client software (210a) and a standard Internet email client (260), which are wholly incompatible, and require a server to convert information into and out of GIF files. (paragraphs [0032] and [0043]-[0046])

Claim 58 describes that said second application is further executable to store said second email message generated for transmission in association with a transmission folder that is accessible with said first application, wherein said first email application is further executable to transmit for receipt by said email server email messages associated with said transmission folder. Contrary to the assertions on page 10 of the office action mailed April 7, 2008, neither Shiigi nor Kelley teach or suggest a transmission folder as described in Claim 58. To the contrary, Shiigi fails to address and is wholly unconcerned with a transmission folder, or a first application executable to transmit an email generated for transmission by a second application that is associated with said transmission folder. Further, Kelley simply describes category identifiers to categorize emails into folders for added user efficiency and friendliness when a user is looking for a particular message. Thus,

neither Shiigi nor Kelley teach or suggest transmission of email messages associated with a transmission folder as described in Claim 58.

Claim 59 describes said processor is further configured to determine if said received email message is compatible with said first application or said second application. Neither Shiigi nor Kelley teach or suggest a communication terminal with a processor configured to determine if a received email message is compatible with a first or a second application. To the contrary, Shiigi teaches away by describing a server that converts email message attachments to a format compatible with a client computer prior to transmission to the client computer (paragraphs [0043]-[0046]), and Kelley is completely silent and wholly unconcerned with compatibility of email messages with applications.

Claim 60 describes said first type of email message is storable in association with a predetermined reception folder that is associated with said first application, and said second type of email message is storable in association with a folder identified with said email message, wherein said second type of email message is storable in association with said second application. While Kelley describes storage of emails in folders, neither Kelley nor Shiigi teaches or suggests folders in association with a first application or a type of email message storable in association with a second application. As previously discussed, Shiigi has no reason for association of email messages with different applications, and Kelley is simply focused on categorizing emails for user efficiency in locating stored email messages.

Claim 63 describes that said control unit is further configured to store, in a specified storage area, a second email message generated with said second application for transmission, and to execute said first application to transmit said second email message, said second email message generated with said second application to include indication of a destination email address. In sharp contrast, Shiigi describes either a standard Internet email client 260, or a handwriting Java client (210a) that each operate wholly independently of each other to send and receive email (paragraph [0032]), and Kelley is completely silent regarding execution of a first application to transmit and email message generated with a second application as described in Claim 63. Thus, Applicant respectfully traverses the rejection of Claim 63 on page 12 of the office action mailed April 7, 2008.

Claim 64 describes that the communication terminal further comprises a storage in communication with said control unit, wherein said storage is a removable storage unit detachably coupled with said communication terminal; and an identifier of said second application is stored in said storage in accordance with said first email message and said second email message. On pages 14 and 15 of the office action mailed April 7, 2008, it was asserted that Shiigi described storage of an identifier of a second application, however, the cited portions of Shiigi simply describe storage of a pixel data representative of a drawing (paragraph [0054]) and that a handwriting Java client can be stored in a memory of a mobile client computer (paragraph [0086]), but is wholly silent regarding storage of any form of identifier of an application. Moreover, neither Kelley nor Ueno make up for this deficiency since Kelley is

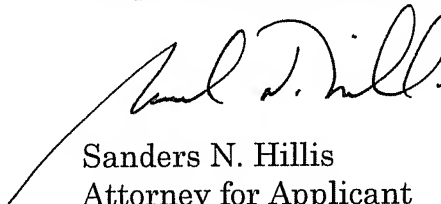
completely silent, and the cited portion of Ueno simply describes a removable memory stick without any teaching or discussion that an identifier of an application is stored therein.

Claim 65 describes that the second email message generated, with the second application that is stored in the specified storage area is stored in the storage in a transmission box folder, and the first application is executable with the control unit to check for the second email message stored in the transmission box folder, and read out the second email message stored therein for transmission to the email server. Contrary to the assertions on page 15 of the office action mailed April 7, 2008, none of Shiigi, Kelley or Ueno teach or suggest an application executable to check for the second email message stored in the transmission box folder, and read out the second email message stored therein for transmission to the email server as described in Claim 65. Applicant respectfully asserts that the scope and content of the cited references have been inaccurately determined. (See MPEP §2141(II.A.))

For at least the foregoing reasons, Claims 53-67 are patentable over the cited references, either alone or in combination. Accordingly, Claims 53-67 are allowable, and Applicant respectfully requests the issuance of a Notice of Allowance for this

application. Should the Examiner deem a telephone conference to be beneficial in expediting allowance/examination of this application, the Examiner is invited to call the undersigned attorney at the telephone number listed below.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Sanders N. Hillis". The signature is fluid and cursive, with a long, sweeping underline that extends to the left.

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